

Appl. No. 09/741,272
Atty. Docket No. 8371
Amdt. dated October 27, 2003
Customer No. 27752

REMARKS

Claims 1 to 31 are canceled without prejudice.

New claims 32 - 39 have been added. Claims 32-39 are supported in the original specification as described in detail below. Claims 32-39 are drafted towards the elected species of the current invention, compound 7 in the specification.

It is believed that these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC 112, First Paragraph

First Rejection (Section 4 of the Office Action)

The term "about" as used in prior claim 18 has been rejected by the Examiner pursuant to 35 USC § 112 ¶ 2. New claims 32-39 have been added in the current application. The term "about" is not present in the newly added claims herein. As such, Applicants respectfully assert the rejection is overcome.

Second Rejection (Section 5 of the Office Action)

The Office Action rejects claims 2, 4, 11 18-23, 25, 27, 29 and 30 under 35 USC § 112, first paragraph. The Examiner alleges that the proviso in the last line of section (f) of prior claim 18, concerning the relationship between R^4 and R^5 and requiring the presence of an oxygen atom in R^5 when R^4 is a carbon atom, lacks description and constitutes new matter. Per the Examiner's suggestion, variable r is shown to be 1 independent of the status of variable R^4 in the new claims. Claims 32-39 embody the elected species of the current invention wherein r has been amended in new claim 32 part (f) as 1, thereby requiring the presence of an oxygen atom when R^5 is $-OR_6$. To this end, given variable r is restricted to 1. R^5 can alternatively be shown as $-OR^6$ and is claimed specifically as such in claims 33 and 34. In addition, Claim 35 recites an embodiment of the elected species of the current invention wherein R^5 is $-NR^6(R^7)$ as also originally described in the specification. Applicant respectfully overcomes the Examiner's rejection under 35 USC § 112 ¶ 1, based on the restriction made in claim 32 part (f) requiring r to equal 1 when R^5 is $-OR_6$. This amendment provides a genus incorporating all of Applicants' working examples and is clearly allowable, as noted by the Examiner.

The chemical structures of the new claims are supported in the specification as the elected species of the current invention shown in compound 7 and Table 4 of the specification. In addition, pages

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7-10 of the specification describe groups that can be formed at R¹, R², R³, R⁴, R⁵, R⁶, and R⁷ on the compounds disclosed in new claims 32-39. Groups that can be formed at R⁸ and R⁹ of claims 32, 39 and 40 are described on page 13, lines 1-7 of the specification.

The pharmaceutically acceptable carriers, claimed in new claims 38 and 39 are described in detail on pages 15-20 of the specification. Applicants respectfully overcome the 35 USC § 112 rejection of the claims.

In addition, a method of treating multi-drug resistance of claim 39 is described in the specification of the current invention on pages 26-28. Applicants respectfully traverse a 35 USC § 112 rejection and assert that a method of treating multi-drug resistance is enabled in the specification of the current invention.

Response to Section 6 of the Office Action

Claim 37 repeats the compound structures of prior claim 24 in independent form with the relevant limitations of the compounds of the elected species of the current invention being fully described and shown in new claims 32-39. Applicants assert that the new claims are appropriately responsive to Section 6 of the Office Action and should therefore be allowed.

Conclusion

In light of the above remarks in response to the last office action, it is requested that the Examiner reconsider the present application and withdraw the rejection under 35 USC § 112. Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the elected species of the current invention. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the new claims presented herein, and allowance of Claims 32-39.

Respectfully submitted,

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